

controlling the fracture gradient of the formation by flowing the flowbore fluid from the control system body proximate to the formation.

59. (withdrawn) A method of drilling a well comprising:
- drilling the well using a drill bit attached to a drill string;
 - flowing flowbore fluid through the drill string having a flowbore therethrough;
 - flowing flowbore fluid through a valve mechanism in the flowbore while maintaining the flowbore fluid in the drill string;
 - adjusting the valve mechanism with an actuator;
 - operating the actuator with an operating system;
 - controlling the temperature of the flowbore fluid by controlling the pressure drop across the valve mechanism; and
 - controlling the fracture gradient of the formation by flowing the flowbore fluid from the control system body proximate to the formation.

REMARKS

Claims 1-33, 37-39, and 41-57 remain in this application. Claims 34-36 and 40 have been canceled. Claims 58 and 59 have been withdrawn.

The examiner states that claims 5, 8-12, 24, 27-31, 47-50, and 55-57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

I. ALLOWABLE SUBJECT MATTER

The examiner states that claims 5, 8-12, 24, 27-31, 47-50, and 55-57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The applicants respectfully submit that base claims 1, 22, 41, and 51 are in condition for allowance as discussed above. Therefore, the applicants respectfully request that the examiner remove the objections to claims 5, 8-12, 24, 27-31, 47-50, and 55-57.

II. FINALITY STATUS OF THIS ACTION

In the applicants' previous reply to the first Office action, the applicants entered amendments and remarks believed to place the claims in condition for allowance based on the art of record. The examiner even admits that the previous amendments and remarks were persuasive and withdrew the rejections. However, now, upon art not previously of record, the examiner enters a "self-admitted" new grounds for rejection and makes this Action final.

As such, a second or any subsequent action on the merits should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.¹ While the rules no longer give an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," hasty and ill-considered final rejections are not appropriate. The applicants are seeking claims that will give them the patent protection to which they are justly entitled and should not be prematurely cut off in the prosecution of the application. The claim amendments and remarks made in the previous reply were not so substantive as to not have been reasonably expected. The applicants did not add any new elements, but merely more

¹ MPEP § 706.07(a).

clearly defined the elements previously submitted in the claims. The applicants submit that they are entitled to a full and fair hearing and thus respectfully request that the examiner withdraw the finality status of the Office action.

III. CLAIM OBJECTIONS

The examiner objected to claim 43 alleging that the recitation of "the valve sleeve" lacks proper antecedent basis. The applicants amend claim 43 to introduce a multi-position valve sleeve submit that the claim amendment satisfies the examiner's objections. The applicants therefore respectfully request that the examiner withdraw the objection to claim 43.

IV. CLAIM REJECTIONS – 35 U.S.C. §102

A. The Examiner's Statements

The examiner rejected claims 1-4, 6, 7, 13-26, 32-33, 37-39, 41-46, and 51-54 under 35 U.S.C. §102(b) as being anticipated by Bishoff (U.S. Patent No. 5,215,444).

B. The Law

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.² The identical invention must be shown in as complete detail as is contained in the ... claim.³ In addition to disclosing every claim limitation, an anticipatory prior art reference must enable the practice of the invention and describe it sufficiently to have placed it in the possession of a person of ordinary skill in the field of the invention.⁴

C. Rejection of Claims 1-4, 6, 7, 13-26, 32-33, 37-39, 41-46, and 51-54

Claims 1-4, 6, 7, 13-26, 32-33, 37-39, 41-46, and 51-54 are not anticipated by Bishoff because Bishoff does not disclose a valve mechanism that controls the flow through a flowbore that extends through the length of the control system body while maintaining the flowbore fluid in the flowbore. The examiner states that Bishoff teaches flowbores "throughout" the control system body. Bishoff does disclose using multiple flowbores. However, Bishoff only discloses one flowbore, defined by inlet (40) and outlet (42), that extends "through the length" of the control system body. Contrary to the claim requirements

² *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

³ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

⁴ *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

though, the Bishoff valve mechanism does not control fluid flow though and maintain the fluid in the flowbore defined by inlet (40) and outlet (42). Thus, Bishoff does not teach a valve mechanism that controls flow through a flowbore that extends through the length of the control system body while maintaining the flowbore fluid in the flowbore that extends through the length of the control system body as required by the claims. The applicants therefore respectfully submit that the rejection is unsupported by the art and request that the examiner withdraw the rejection with respect to the claims.

V. STATEMENT REGARDING CLAIMS

The applicants have argued the allowability of the claims by addressing the comments by the examiner in this paper as well as previously during the prosecution of this application. By doing so, the applicants are in no way limiting their ability to argue additional points of novelty regarding the independent claims or dependent claims at a later date.

CONCLUSION

The applicants respectfully request reconsideration the rejected and objected to claims and that a timely Notice of Allowance be issued in this case. If the examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

In the course of the foregoing discussions, the applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. There may also be other distinctions between the claims and the prior art that have yet to be raised, but that may be raised in the future.

Unless the applicants have specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention and the amendment was not for the purpose of patentability. Further, although the applicants may have amended certain claims, the applicants have not abandoned their pursuit of obtaining the allowance of these claims as originally filed and reserve, without prejudice, the right to pursue these claims in the future.

If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769 (ref. 1391-46000) of Conley Rose, P.C., Houston, Texas.

Respectfully submitted,
CONLEY ROSE, P.C.

A handwritten signature in black ink, appearing to read "Collin A. Rose". The signature is fluid and cursive, with the first name "Collin" and last name "Rose" being more prominent than the middle initial "A".

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